

REMARKS

The Examiner's Action of June 23, 2003 has been received and its contents carefully considered. Reconsideration is respectfully requested in view of the following comments.

Claims 1-11, 15-17, 21-25 and 30 are pending in the instant application.

I. Personal Interview of September 24, 2003

Applicants' representative, Laleh Jalali, would like to thank the Examiner for having granted a personal interview on September 24, 2003. As discussed during a brief telephone conference with the Examiner on September 5, 2003, the instant Response is being submitted prior to the interview date in order to avoid the payment of extension fees, to the extent that the due date for a Response to the outstanding Office Action is prior to the interview date.

II. Allowable Subject Matter

Applicants would like to thank the Examiner for the indication of allowable subject matter in claims 6-9, 16 and 22. In view of the argued allowability of independent claims 1, 15 and 21 from which the claims above respectively depend, the claims indicated as containing allowable subject matter are being retained as dependent claims in the instant Response.

III. Priority

The Examiner has indicated the absence from the Declaration already submitted of one of the three application on which priority is based. In response, Applicants will submit in due course a new declaration listing all of the foreign application on which priority is based.

IV. Rejection under 35 USC 102(e)

Claims 1, 4, 5, 10, 15 and 21 have been rejected under Section 102(e) as being anticipated by Yoshimura et al. Reconsideration is respectfully requested.

Yoshimura et al. pertain to an inexpensive and corrosion resistant metal-made gas separator which includes a base formed by joining formed stainless steel base sheets face to face. The base carries on each of the opposite surfaces thereof a first coating layer formed by plating with tin. The base is also coated with a second coating layer of a thermal expansion graphite. When incorporated into a fuel cell, the separator contacts gas diffusion electrodes that are formed from a carbon material similar to the carbon material of the second coating layer, so that the contact resistance is reduced. The first coating layer is formed after a passive state coating is removed from the stainless steel surface, so that an increase in the internal resistance of the separator caused by the passive state coating is substantially prevented.

For prior art to anticipate under § 102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference. Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation. Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983) (“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. (Citation omitted) A prior art disclosure that “almost” meets that standard may render the claim invalid under § 103; it does not “anticipate”.) ...if the claim does not literally read, there is no anticipation. Lewmar Marine, Inc. v. Barient Inc., 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987).

Yoshimura et al. fail to disclose a fuel cell gas separator or a method for manufacturing a fuel cell gas separator where a separator base material is formed from a metal, a noble metal coating layer is provided on the base material, and a carbon coating layer is formed on the noble metal coating layer, as set forth in independent claims 1, 15, and 21. The above features of the instant invention are missing from Yoshimura et al. The Examiner states at page 6 of the Action, that “Yoshimura et al. teaches [sic] a base metal coating of a material such as a noble metal is known.” However, “a base metal” is by definition not noble metal. The Encarta Dictionary at

www.encarta.com defines a “base metal” as “as a common inexpensive metal, for example, copper, iron, lead, tin, or zinc, as distinguished from the precious metals of gold, silver, and platinum.” To the extent that nowhere in Yoshimura et al. is there a disclosure of a fuel cell gas separator or a method for manufacturing a fuel cell gas separator where a metal base material has a noble metal coating layer provided thereon, and where the noble metal coating layer is coated with a carbon coating, as set forth in the independent claims, Yoshimura et al. cannot possibly anticipate the instant invention as set forth in independent claims 1, 15 and 21 under Section 102.

The Examiner further refers to In re Boe, 148 USPQ 507 (CCPA 1966), for the proposition that “non-preferred embodiments or teaching that are unsatisfactory for the intended purpose may be relied upon for what they would fairly teach one of ordinary skill in the art.” First, it is noted that, to the extent that the instant rejection is being made under Section 102, what may fairly be taught to “one of ordinary skill in the art” is not a factor in the assessment of whether the prior art anticipates the claimed subject matter. “Ordinary skill” would be pertinent to an obviousness argument, which is not what is at issue here. In addition, Yoshimura et al.’s teaching regarding noble metals is by no means a disclosure of a “less preferred embodiments or teachings” as set forth by the Examiner. In fact, the use of noble metals is to be expressly avoided accordingly to the teachings in Yoshimura et al in favor of base metals such as tin, and is therefore not part of the any of the embodiments of that reference. The attention of the Examiner is referred to in this regard to Yoshimura et al. at column 1, fourth full paragraph; column 2, lines 13-20; column 6, lines 10-14; column 7, second full paragraph; and paragraph spanning columns 8 and 9. Yoshimura et al clearly wish to avoid the use of noble metals for cost cutting purposes, as set forth in their patent. In addition, Yoshimura et al. clearly teach away from the use of a second coating layer made of noble metal for another, equally important reason. Yoshimura et al. at column 1, fourth full paragraph, set forth the disadvantages of using noble metals to impart a separator with improved corrosion resistance, one of them being a less than optimal corrosion resistance of such metals. However, Yoshimura et al. go even further by disclosing that a way to avoid the above disadvantage is to either “restrict the effect of corrosion starting at holes in a coating surface within an allowable range,” or to coat the noble metal layer with nickel. Nowhere in Yoshimura et al. does the reference disclose that the noble metal layer could further be coated with a carbon layer.

In view of the above, it is submitted that independent claims 1, 15 and 21 are patentable over Yoshimura et al. It is further submitted that dependent claims 4, 5 and 10 are likewise patentable over Yoshimura et al. for being dependent from independent claim 1, and further for the particular additional features that they recite.

V. Rejection under 35 USC 103(a)

Claims 2, 3, 11, 17, 23 and 25 have been rejected under Section 103(a) as being unpatentable over Yoshimura et al. in view of Hawley's Condensed Chemical Dictionary, page 835 (Hawley's). Reconsideration is respectfully requested in view of the following comments.

Hawley's does nothing to overcome the deficiencies of Yoshimura et al. noted in Section IV above. Therefore, no reasonable combination of Yoshimura et al. and Hawley's would in any event result in the instant invention as recited in either of claims 2, 3, 11, 17, 23 and 25, which depend from corresponding ones of independent claims 1, 15 and 21 discussed above.

Accordingly, it is submitted that claims 2, 3, 11, 17, 23 and 25 are patentable over the cited combination of references. Therefore, it is respectfully requested that the Examiner reconsider and withdraw his rejection of the claims under Section 103(a).


CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration, withdrawal of all grounds of rejection and issuance of a Notice of Allowance are solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned at (202) 220-4296 to discuss any matter regarding this application.

Respectfully submitted,
KENYON & KENYON

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